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LUD 5664 US (10017134)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	DUMOUTIER, et al
Serial No.	:	09/626,617
Filed	:	July 27, 2000
For	:	ISOLATED NUCLEIC ACID MOLECULES WHICH ENCODE T CELL INDUCIBLE FACTORS, OR INTERLEUKIN-21, THE PROTEINS ENCODED, AND USES THEREOF
Group Art Unit	:	1644
Examiner	:	A. Decloux

September 30, 2002

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231
Attn: Technology Center Director
Group 1600

PETITION TO HAVE AMENDMENT ENTERED (MPEP 1002.02(c), 714.19, 37 C.F.R. §1.127

Applicants hereby petition to have the amendment of April 18, 2002 entered. No fees are believed due, but should this not be the case, authorization is given to charge the fees to Deposit Account 500624.

The operative facts are as follows. When this application was filed, originally, claim 1 was the broadest claim presented, and it read as follows:

> 1. A method for stimulating expression of a STAT transcription factor comprising contacting a cell capable of said expression with an amount of IL-TIF/IL-21 to said cell sufficient to stimulate said expression.

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Claim 1 was examined and found free of the prior art. See the office action of July 16, 2001, paper number 8.

This rejection was reiterated in the office action of December 26, 2001. Claim 1 was not amended following the July 16, 2001 amendment, so the same claim was considered on December 26, 2001.

Applicants presented claims 22-32 in an Amendment, dated April 18, 2002. Claim 32 is problematic. Due to its dependency structure, applicants reproduce claims 22, 23, 31 and 32 of that amendment.

22. A method for stimulating expression of STAT3 transcription factor, comprising contacting a cell capable of said expression with an amount of an IL-TIF/IL-21 sufficient to stimulate said expression.

23. The method of claim 22, wherein said IL-TIF/IL-21 is mammalian IL-TIF/IL-21.

31. The method of claim 24 (sic; 23), wherein said mammalian IL-TIF/IL-21 is murine IL-TIF/IL-21*.

32. The method of claim 31, wherein said murine IL-TIF/IL-21 also stimulates expression of STAT5 transcription factor.

On July 9, 2002, the examiner stated that the amendment would not be entered because:

> "The limitation in newly proposed method claim 32, that IL-TIF/IL-21 stimulates expression of STAT5 transcription factor, raises new issues that would require further consideration and/or search since STAT5 transcription was never searched or considered. Furthermore, a search for a method for stimulating the expression of STAT3 transcription factor comprising contacting a cell with an IL-TIF/IL-21 wherein said IL-TIF/IL-21 is murine IL-TIF/IL-21 which also stimulates expression of STAT5, was not previously contemplated."

*Applicants note the incorrect dependency of claim 31. They are willing to correct it; however, claim dependency has not been raised by the examiner.

ARGUMENT

As will be seen from review of claim 1, presented supra, it placed on limits on the nature of the IL-TIF/IL-21. It also placed no limits on the type of STAT transcription factor, the transcription of which is stimulated. Yet, this claim was found free of the art, twice.

Allegedly problematic claim 32 stands as a species of original claim 1, which was found free of the prior art. It specifies (i) the type of IL-TIF/IL-21, and (ii) the type of STAT transcription factor stimulated. Specifically, STAT3 and STAT5 must both be stimulated.

No issues were raised as claims 22, 23, or 31 with respect to need for further search. Yet, each is broader than claim 32. Claim 23 presents no limits on the type of IL-TIF/IL-21. Claim 23 is broader than murine, in specifying that the type of IL-TIF/IL-21 is mammalian. Claim 31 specifies murine IL-TIF/IL-21, and no objections were raised thereto. Hence, the only possible basis for objection is the recitation of STAT5 as a stimulated molecule. As is pointed out, supra, the stimulation of STAT5 is in addition to STAT3. The examiner did not object to the recitation of STAT3.

The MPEP states, in relevant part:

> "Substantially every claim includes within its breadth of scope one or more variant embodiments that are not disclosed in the application, but would anticipate the claimed invention if found in a reference. The claim must be so analyzed and any such variant encountered during the search should be recognized."

See MPEP 904.01(a). Claim 1, examined twice, was found free of prior art. No embodiments within claim 1 were found. Hence, it must be concluded that the embodiment of claim 32 does not exist in the prior art. If it did, then presumably, it would have been cited against claim 1; however, as noted, no embodiments against claim 1 were found.

Further, it is not unreasonable to have assumed that an embodiment where murine IL-TIF/IL-21 stimulates expression of STAT3 and STAT5 was searched, since this is a disclosed embodiment. Example 21, at pages 21-22, which shows murine IL-TIF/IL-21 stimulating both STAT3 and STAT5.

Applicants attempted to resolve this with the examiner, as can be seen by their response of July 22; however, on July 29, the examiner issued an advisory action, stating that since the paper "was not filed under 37 CFR §1.116, nor is it in the form of a petition," it would not be considered.

With respect to 37 CFR §1.116, filing the reply thereunder would have been improper, as applicants were not responding to a final rejection.

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It is true that a petition would have been appropriate on July 22; however, it was believed that it would be possible to address the issues without the need to file the petition.

Applicants delayed in filing this petition because there was a telephone interview on July 18, which is not completely summarized in the examiner's report. Applicants believed that the examiner would withdraw the objections, as she indicated that she discussed the issues with, inter alia, Steven Kunin, who states withdrawal was appropriate. Please see applicants' response of July 22 on this issue.

In view of the foregoing, it is believed that entry of the April 18, 2002 amendment is proper, and is requested.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

By: _____

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